

The Intellectual Property Law Section of the State Bar of California presents

INTELLECTUAL PROPERTY *for* IN-HOUSE COUNSEL

MAY 22, 2007

Le Méridien at Beverly Hills

465 S La Cienega Blvd.
Beverly Hills
Los Angeles, California 90048
Phone: (310) 247-0400

Earn 7.25 Hours MCLE Credit

Register Online:

www.calbar.ca.gov/ipsection

The Intellectual Property Law Section of the State Bar of California gratefully acknowledges the assistance of the Association of Corporate Counsel's Intellectual Property and Information Technology & E-commerce Committees to promote this Program.



PROGRAM SCHEDULE

8:00-9:00 *Registration*

9:00 *Welcoming Remarks*

9:15-10:00 *45 min. Making the Transition Between Outside Counsel and Inside IP Counsel*

Paradoxically it is often the dream of every Outside Counsel to eventually 'take it easy' and work In-House and for every In-House Counsel to 'work for a real law firm'. What are the environments in 2007 for both of these work experiences and more importantly, how do you make the successful transition from Outside Counsel to In-House attorney?

The panelists will:

- describe the actual working and economic conditions of the In-House Attorney in the: Commercial, University, Non Profit and Government Sectors
- discuss culture shock and the barriers to success in these unique environments
- provide practical guidance to transitioning counsel on fostering new working relationships with 'corporate clients' from the In-House perspective
- provide concrete recommendations for education and training to facilitate a new working environment

MODERATOR:

Georgann S. Grunebach, Assistant General Counsel, DIRECTV, Inc.

PANELISTS:

Dennis Cho, Vice President, Business Affairs and General Counsel, Image Entertainment, Inc.

JoAnna Esty, Partner, Venable, LLP

Joyce L. Morrison, Vice President, Intellectual Property, Xencor Corporation

Mei-lan Stark, Vice President, Intellectual Property, Fox Group Legal

10:00-11:00 *1 hour Content Licensing in the Digital and New Media Age: A Workshop*

The advent of digital and media technology platforms has opened up new opportunities for content owners to license content. But the proliferation of technological platforms has also made the content licensing process more complicated. In this workshop, leading experts will cover practical issues in-house counsel must face when reviewing and negotiating content licensing agreements in the digital universe.

The panelists will:

- review digital and new media technology platforms affecting content licensing negotiations
- identify issues in licensing contract provisions triggered by digital and new media technologies
- analyze common licensing provisions
- discuss best practices for negotiating as either licensor or licensee

MODERATOR:

James D. Nguyen, Partner and Co-Chair, Entertainment & Media Industry Team, Foley & Lardner LLP

PANELISTS:

Nicholas A. Crincoli, Assistant General Counsel, DirecTV, Inc.

Jeffrey A. Korchek, Vice President and Assistant General Counsel, Legal & Business Affairs, Mattel, Inc.

Dean S. Marks, Senior Vice President, Intellectual Property, Corporate Business Development & Strategy, Warner Bros. Entertainment Inc.

Jeff Weitzman, President & COO, Coupons, Inc.

11:00-11:15 *Break*

11:15-12:15 *1 hour Enforcing Your Company's IP Rights on the Internet*

For in-house counsel, the Internet is one of the most common areas where your company's IP rights can be infringed or where your company may draw IP infringement claims against it. Thus, learning how to effectively enforce your company's IP rights on the Internet is critical. This panel will cover how your company can deal with:

- domain name infringement, cybersquatting, and trademark fair use problems
- infringement of copyrighted content on the Internet
- potential trade secret breaches on the Internet
- business method patents claims involving Web-based technologies

PANELISTS:

Blythe Holden, General Counsel, Shopzilla, Inc.

Stacey Oliff, Senior Vice President, Legal & Business Affairs, Fandango

Matthew Polesetsky, Vice President, Business and Legal Affairs, MySpace, Inc.

12:15-1:45 *Lunch 1 hour Career Counseling 101 for In-House IP Lawyers*

This special lunch presentation is a must for in-house IP lawyers looking to expand their careers. In an interactive discussion with the audience, the panelists will give:

- an overview of the job market for in-house IP lawyers
- advice on how to move up the ladder in your legal department or company
- practical tips on finding your next in-house position
- ideas for best resources to use for network, career advancement and job placement

PANELISTS:

Anna Armstrong, Senior Consultant, Head of In-House Division & Diversity Recruitment, MLegal Consulting, Inc.

Sharon Gerber, Sharon Gerber Attorney Search

Dean S. Marks, Senior Vice President, Intellectual Property, Corporate Business Development & Strategy, Warner Bros. Entertainment Inc.

1:45-2:30 45 min. Managing Outside Counsel and Vendor Costs

The savvy in-house IP counsel is not only responsible for the technology bottom line of his corporate client, but also for the economic health of his IP budget! It's imperative that in-house counsel understand not only how to foster the generation of significant new technology, but also how to cost effectively capture that IP within the constraints of an ever dwindling budget.

This panel will provide practical suggestions on:

- selecting cost effective outside counsel
- tracking budgetary expenditures
- ethically working as a licensed patent attorney within budgetary constraints
- creative solutions to be '100 places at once' by fostering an innovative environment

through the use of educated support staff and engineering management seeking, fostering and maintaining executive management financial support

MODERATOR:

Georgann S. Grunebach, Assistant General Counsel, DIRECTV, Inc.

PANELISTS:

Leonard A. Alkov, Senior Patent Counsel, Raytheon, Inc.

Steven O. Gasser, General Counsel, Zappos.com, Inc.

2:30-3:30 1 hour Demand and Cease & Desist Letters: A Workshop

One of the trickiest areas is how to respond or initiate a demand, licensing and/or cease & desist letter. On the response side: do you seek outside counsel?; do you get a written opinion? how best to respond? Certainly, in the patent and other arenas, there are ramifications for responding or not responding. On the initiation side, similar questions loom. How much due diligence does one conduct before sending a letter? How aggressive should the letter be? Should it come from the company or from outside counsel?

This panel will provide guidance on:

- how to initiate and respond to a demand and/or cease & desist letter
- when it is prudent to seek the opinion of outside counsel and how much to get them involved
- practical tips on timing and drafting such letters and/or responses

MODERATOR:

Ted Herhold, Partner & Chair of Litigation Practice Group, Townsend and Townsend and Crew LLP

PANELISTS:

Scott Coonan, Director of IP Litigation and Licensing, Juniper Networks

Jubian Dana, Senior Counsel, Visa U.S.A. Inc.

Philip H. Lam, Intellectual Property Counsel, Office of the City Attorney, City of Los Angeles

3:30-3:45 Break

3:45-4:30 45 min. The New Federal E-Discovery Rules and Their Impact on In-House IP Counsel

Electronically-stored information is especially important for intellectual property litigation. This panel discussion will cover the challenges presented by electronic data, the recently-amended Federal Rules of Civil Procedure (effective December 1, 2006), and the real-life implications for in-house IP counsel:

- dealing With the New Rules in Pending and Future IP Cases
- how to Evaluate Your Company's Current Document Retention Policies, Implement Litigation-holds, and Other Technology Considerations Unique to IP Matters
- cost-Effective Management of Electronic Evidence Issues Involving IP Matters

MODERATOR:

Michael F. Kelleher, Partner, Folger Levin & Kahn LLP

PANELISTS:

Jill Dessalines, Assistant General Counsel, McKesson Corporation

Ronald E. Naves, Senior Vice President, Legal Affairs and Litigation, Gemstar-TV Guide International, Inc.

Patrick Oot, Director of Electronic Discovery & Senior Counsel, Verizon

4:30-5:30 1 hour Ethical Issues for In-House IP Counsel

In-house intellectual property attorneys must often confront many unique and potentially troubling ethical issues. In this session, the panelists will help guide in-house counsel through some of these ethical minefields, including:

- for patent in-house counsel, who really IS the client: the corporation or the corporate inventor
- issues of co-inventorship between a corporate client and the attorney representing the corporate interests
- What are patent and trademark counsel's duties and obligations of confidentiality under the USPTO Rules?
- Patent and trademark opinions: what to do when your business clients question your opinion or ask you to "re-think" the opinion
- Fraud in trademark applications: the impact of the *Medinol* on due diligence during the trademark prosecution process and whether in-house trademark counsel sign trademark Statements of Use

PANELISTS:

Victor Cooper, Partner, Gates & Cooper LLP

John McDermott, Professor of Law & Director, Special IP Focus Series, Loyola LA Law School

5:30-7:00 Hosted Cocktail and Networking Reception

INTELLECTUAL PROPERTY *for* IN-HOUSE COUNSEL

REGISTRATION INFORMATION

Online Registration

www.calbar.ca.gov/ipsection

Registration by Mail

Your registration must be received *no later than Friday, May 11, 2007*. Please send your completed registration form and check payable to The State Bar of California to:

Program Registrations

The State Bar of California
180 Howard Street
San Francisco, CA 94105-1639

Registration by Fax

Fax to program registrations at 415.538.2368. Visa/MasterCard ONLY.
Credit card information is mandatory. Photocopies of checks will not be accepted.

On-Site Registrations

On-site registration opens at 8:00am and is subject to space availability.

Cancellations/Refunds

Cancellations and request for refunds must be received in writing *no later than Friday, May 11, 2007*. Substitute registrants are allowed, but must register in their own name.

MCLE Credit

The State Bar of California and the Intellectual Property Law Section are State Bar of California approved MCLE providers. This activity has been approved for 7.25 hours of MCLE credit.

Special Assistance

Please call 415.528.2071 or TDD for speech and hearing impaired 415.538.2231.

Questions

For registration information, please call 415.538.2508. For program content/Section information, please call 415.538.2375.

Audio Tapes

Audio tapes of the program will be available with a complete set of program materials from Versa-Tape. To order, please call 800.468.2737.

Program Planning Committee Co-Chairs

Georgann S. Grunebach
2230 E Imperial Hwy
El Segundo CA 90245
310-964-4615 FAX 310-964-4883
gsgrunebach@directv.com

Matthew A. Neco
VP and General Counsel
Stirling Bridge, Inc., & GC to subs.,
including StreamCast Networks, Inc.
(dba Morpheus [Peer-to-Peer])
20969 Ventura Blvd., Ste. 215
Woodland Hills, CA 91364
818-887-8610 x105
matthew.neco@gmail.com

James D. Nguyen
Foley & Lardner LLP
2029 Century Park E 35FL
Los Angeles CA 90067-3021
310-975-7837 FAX 310-557-8475
jnguyen@foley.com

Richard C. Hsu
Townsend Townsend Crew LLP
379 Lytton Ave
Palo Alto CA 94301
650-326-2400 FAX 650-326-2422
rhu@townsend.com

INTELLECTUAL PROPERTY *for* IN-HOUSE COUNSEL

MAY 22, 2007

Le Méridien at Beverly Hills
Beverly Hills, California

REGISTRATION FORM

Register Online:
www.calbar.ca.gov/ipsection

State Bar Number _____

Name _____

Firm _____

Address _____

City, State, and Zip _____

Phone _____ FAX _____

Email Address* _____

*Required for Email Confirmation

- ☐ Your name and address may be disclosed. Please check here if you do not want your information released.

Registration Fees (check appropriate box)

- ☐ \$295 Members of the State Bar of California Intellectual Property Law Section
- ☐ \$295 Members of the Association of Corporate Counsel
- ☐ \$365 Non-Member of the State Bar of California Intellectual Property Law Section (2007 Section Membership Included)
- ☐ \$385 All Registrations after Friday, May 11, 2007 (2007 Section Membership Included)
- ☐ \$50 Law Students (please provide copy of student identification)

Credit Card Information

I authorize the State Bar of California to charge my program registration fee to my VISA or MasterCard account. (No other credit cards will be accepted.)

Acct. #: _____ Exp. Date: _____

(VISA or MasterCard ONLY)

Cardholder's Name: _____

Cardholder's Signature: _____

Mail to: Program Registrations, The State Bar of California, 180 Howard Street, San Francisco, CA 94105. Make checks payable to The State Bar of California.

Tax to: Program Registration at 415.538.2368. Credit card information is mandatory.

The State Bar of California and the Intellectual Property Law Section are State Bar of California approved MCLE providers.

STATE BAR EDUCATION FOUNDATION

Intellectual Property Law Section
180 Howard Street
San Francisco, CA 94105

First Class PRSRT
U.S. POSTAGE

PAID
Documentation

INTELLECTUAL PROPERTY *for*
IN-HOUSE COUNSEL

MAY 22, 2007

Le Méridien at Beverly Hills

465 S La Cienega Blvd.

Beverly Hills

Los Angeles, California 90048

United States

Phone: (310) 247-0400